

# USPTO Public Forum

## 2014 Interim Guidance on Patent Subject Matter Eligibility

Anthony D. Sabatelli, PhD, JD

January 21, 2015

# Overview

- Necessity for a Guidance
  - A further step in the right direction . . . but, not yet far enough?
- Positive Aspects of the Interim Guidance
- Critique of the Interim Guidance
  - Still too complex?
  - Confusing detour for nature-based products?

**Opportunity for the PTO to Take the Lead and Get it Right**

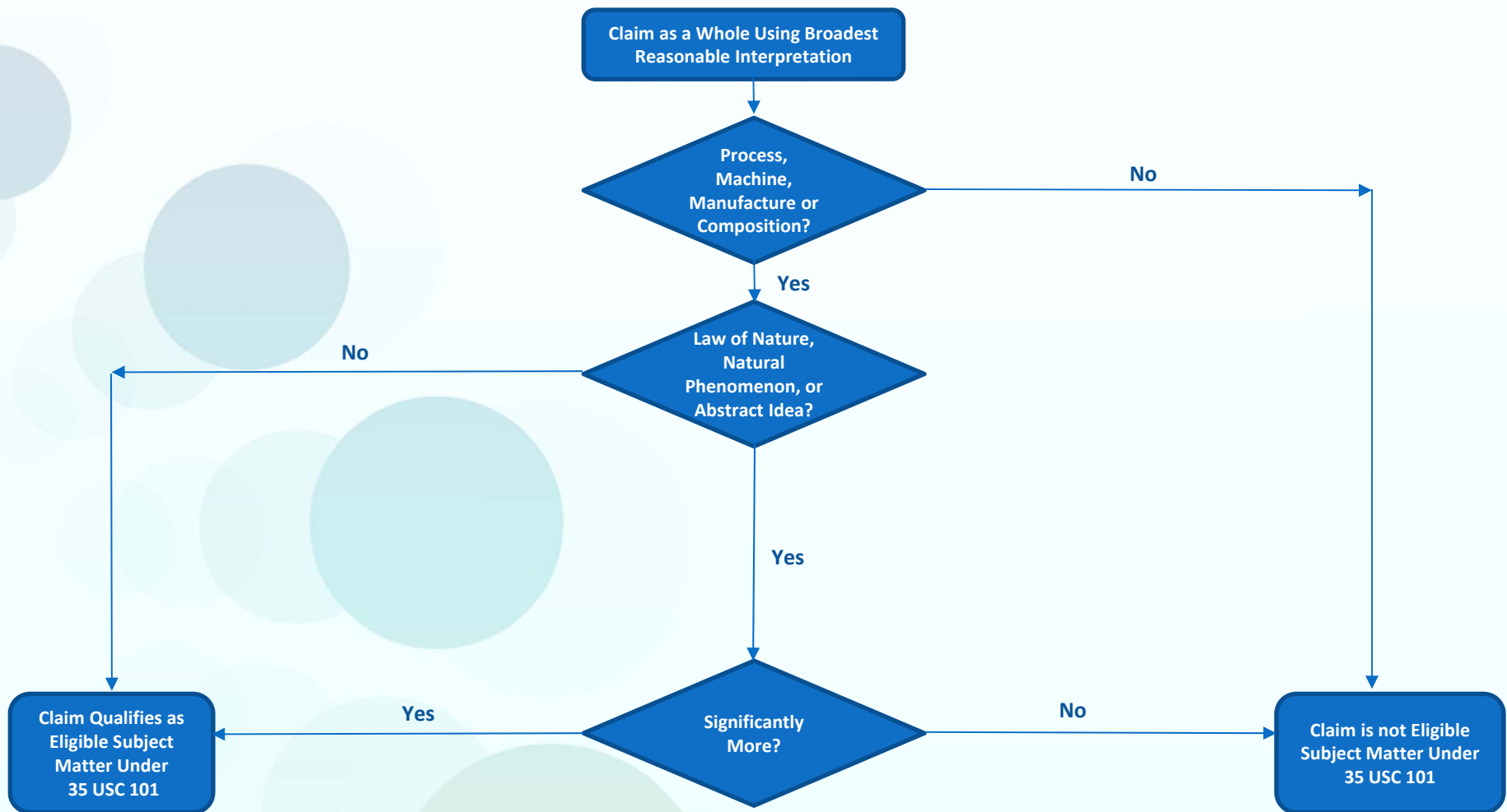
# Interim Guidance: Positive Aspects

- Strives for consistency across all technologies
- More closely reflects Supreme Court decisions
- Streamlines previous Guidance
  - Discards 12-factor “significantly different” analysis
- Determines whether the “claim *as a whole* is directed to a judicial exception” Fed. Reg., p. 74622
- Instructs Examiners to identify judicial exception and explain basis for §101 rejections Fed. Reg., p. 74624

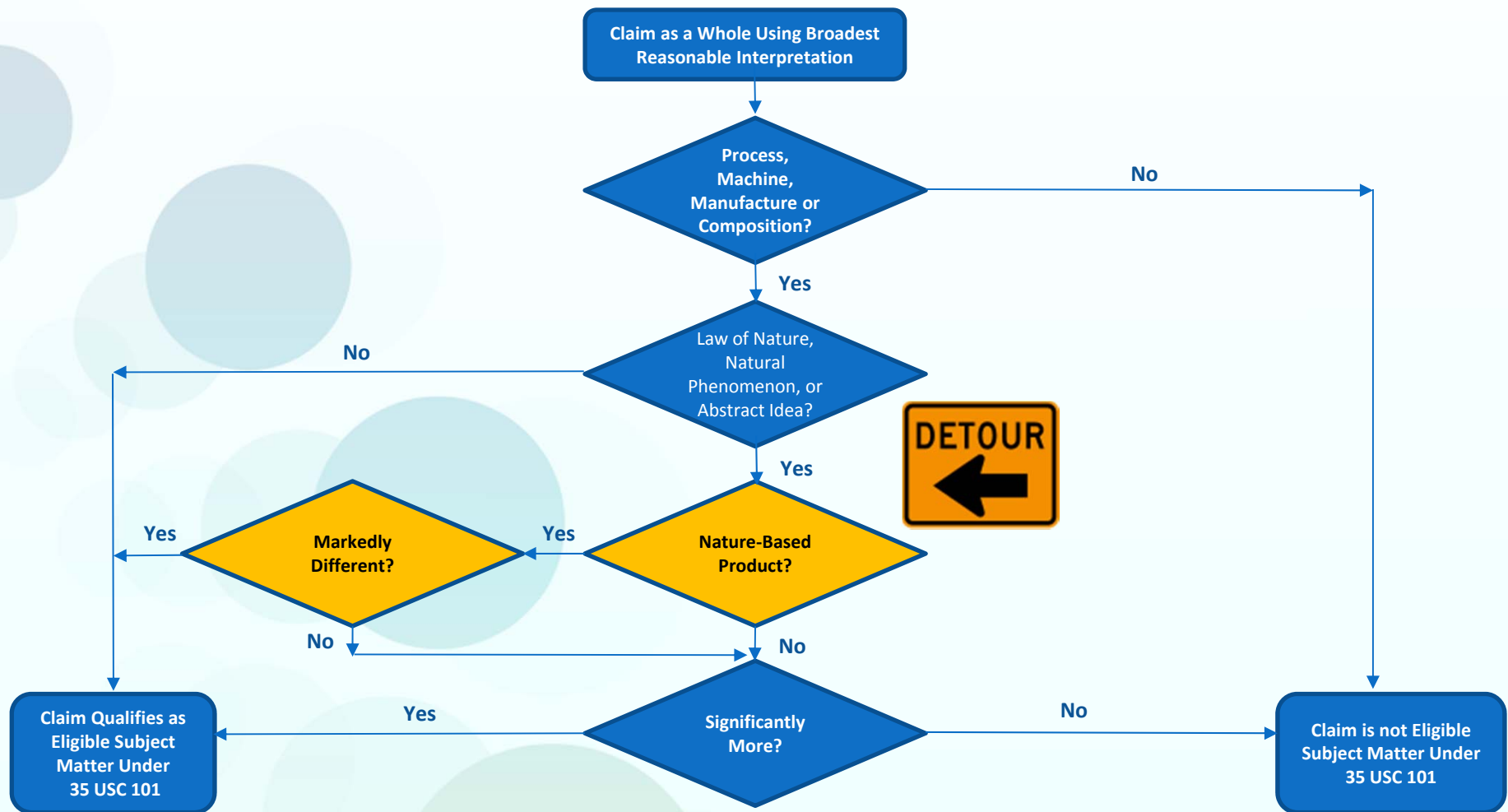
# Interim Guidance: Critique

- Is the framework still too complex?
  - Is the *Mayo* test, as set forth in *Alice Corp.*, really being followed?
    - Does *Mayo* even set forth the test as interpreted by *Alice Corp.*?
- **Why the detour for nature-based products?**
- Is “significantly-more” significantly more confusing?
- Is §101 analysis bleeding-over into §102/103?
- Need for clearer explanation for case law cites

# Patent Subject Matter Eligibility Flowchart



# The Actual Flowchart Has a Detour

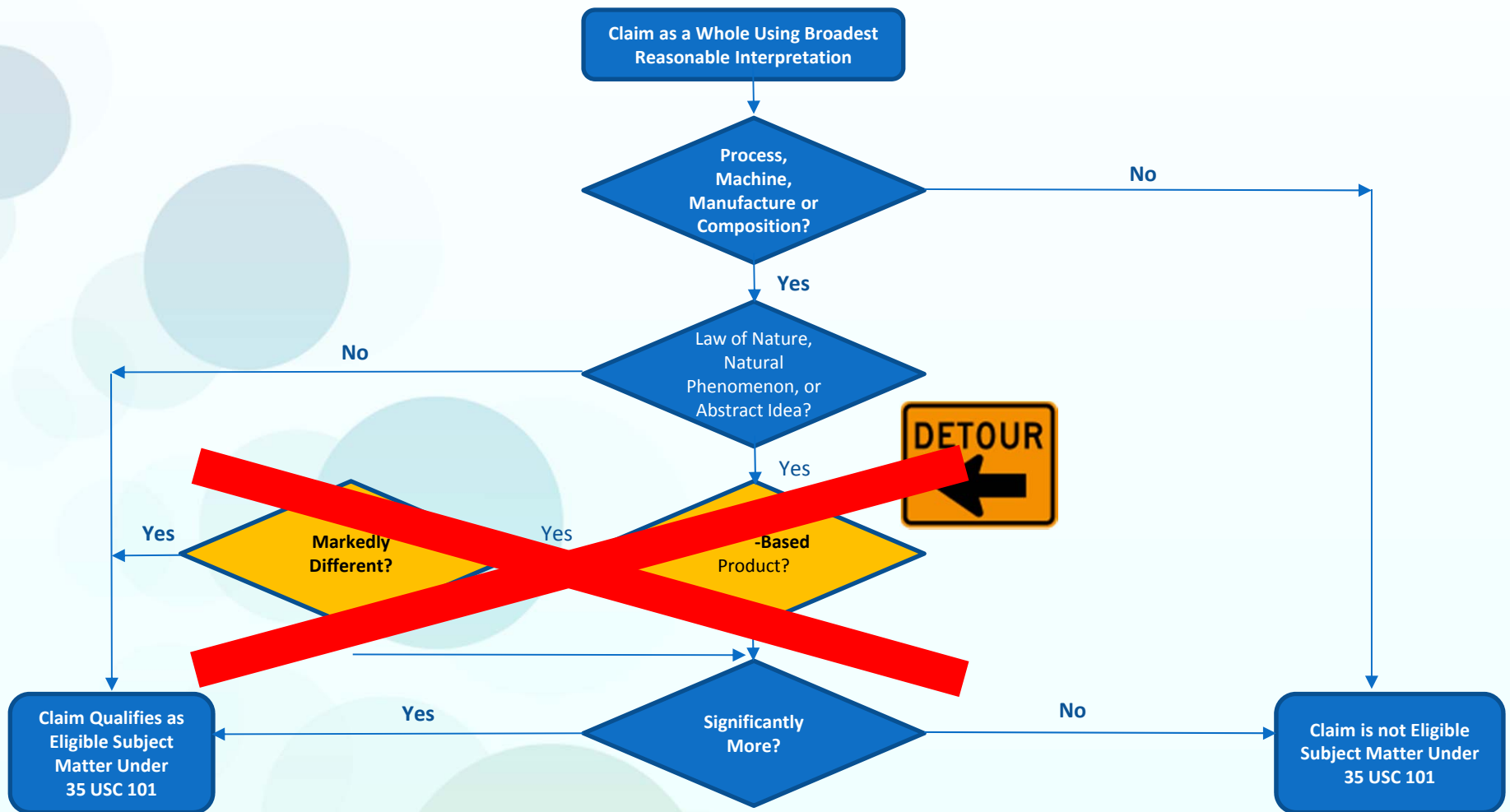


# Why the Detour?

- Diverges from the consistency being sought across all technologies
- Not supported by the *Mayo/Alice Corp.* framework
  - *Chakrabarty* discusses “markedly different”  
but, *Chakrabarty* is not mentioned until footnote 32

**Risk of getting lost by taking the detour**

# Ditch The Detour





# Summary

- The Interim Guidance is necessary
  - a further step in the right direction
- Remove the nature-based product detour
- Better refine the “significantly more” test
  - patent eligibility, *not* patentability is the question
- Need clearer explanation for case law cites

**Opportunity for the PTO to Take the Lead and Get it Right**

# Thank you for your time.

**Anthony D. Sabatelli, PhD, JD**

**Partner, Dilworth IP**

**203-220-8496**

**[asabatelli@dilworthip.com](mailto:asabatelli@dilworthip.com)**

**[www.dilworthip.com](http://www.dilworthip.com)**